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CHARLES ELMORE

IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No.— 246

ALLEN-BRADLEY COMPANY,
Petitioner,

vs.

SQUARE D COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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Aug. 23, 1948.

HAMMERSMITH-NORTHEVER CO.

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To the Honorable the Justices of the Supreme Court of the United States:

The petition of Allen-Bradley Company respectfully represents:

A.

SUMMARY STATEMENT OF MATTER INVOLVED

1. Your petitioner, Allen-Bradley Company (hereinafter called "Allen-Bradley") seeks to review a judgment rendered by the Circuit Court of Appeals for the Seventh Circuit on March 6, 1948 (Rec. p. 2567).

2. Allen-Bradley was plaintiff in an action brought in the District Court of the Northern District of Illinois against Square D Company (hereinafter called "Square D") wherein a judgment was sought that Square

D had infringed two certain patents owned by Allen-Bradley.

3. Upon answering, Square D, by way of counterclaim, sought judgment against Allen-Bradley for infringement of two certain patents owned by Square D.

4. Upon trial, lasting approximately six weeks resulting in an extensive record, the controversy became centered upon one of the two patents of Allen-Bradley and the District Court found that that patent was invalid. The District Court also found the remaining patent of Allen-Bradley to be invalid and the patents upon which Square D was counterclaiming, one to be invalid and the other not infringed. Accordingly, the District Court dismissed both the complaint and the counterclaim. The decree of the District Court appears at (Rec. pp. 109-10) and the opinion of the District Court appears at (Rec. pp. 54-64).

5. On appeal Allen-Bradley, without success, sought to reverse the judgment of the District Court primarily with reference to that patent (*Wilms and Petersen,* No. 2,071,149, Exhibit No. 1, Rec. p. 2481) which was at the center of the controversy, and while a cross appeal was filed with reference to a patent involved under the counterclaim, Square D in effect did not press the merits of its cross appeal. The issues to be determined were virtually concerned with the single patent now in suit, No. 2,071,149. The judgment of the Circuit Court of Appeals affirming the District Court's opinion is found at page 2567 of the Record. The opinion of the Circuit Court of Appeals appears at pages 2553 to 2567 of the Record.

The present petition is filed primarily to secure review of the rule of law applied in measuring patentability of the new and useful subject matter contained in the patent

in suit; which rule of law is inconsistent with, and diametrically opposed to, the measure applied in circuits other than the Seventh Circuit, as well as the measure elsewhere applied within the Seventh Circuit itself and as approved by this court itself to the extent of denying a petition for writ of certiorari.

6. The invention claimed in the patent in suit is an improvement in three phase electric switches for across-the-line starting of machine tool motors. The Circuit Court of Appeals said:

> "* * * The most generous appraisal which we are able to accord to this claimed invention is that the hood was enclosed in such a way as to affect the arcs in a manner that would enable the switch to carry a heavier load". * * * (Rec. p. 2564).

And this is correct connoting as it does that switches can be made in larger capacities.

7. The merit of the improvement was not refuted, either in the District Court or in the Circuit Court of Appeals. Theories advanced by the rival experts as to how the improvement was obtained were in disagreement and in disagreement with the theory of an independent court-appointed expert, but upon appeal the parties were in practical agreement that the impounding of the arcs in ends of the enclosure of each switch by means of the magnetic field was the proper explanation of operation.

8. The novelty involved in the patent in suit as in the case of so many improvements consisted not in a novel element but in a novel combination creating a significant advance in the art of three phase across-the-line motor starters. The exact atomic phenomenon involved was for a time at least baffling. Claims 2, 20, 21, 22, 23, 24 and 26 of Patent 2,071,149 with 21 as typical are involved.

After the decision by the Circuit Court of Appeals as outlined above, petitioner sought a rehearing on the ground that the test of patentability established by the Court in its own decisions when applied to the facts and circumstances in this case called for a determination of patentability and of validity of the claims. The petition was denied on June 29, 1948 (Rec. p. 2568). Thereafter, and within three months, this petition was filed.

B.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

The questions which Allen-Bradley presents for the consideration of the Court and in respect to which the Certiorari is sought are as follows:

First: Where the Court announces as a standard for invention, complying with the requirements of the Statutes as to patentability, that a modicum of utility and a modicum of novelty are sufficient, and in a subsequent decision refuses to apply such standard, is there not such inconsistency as requires the supervisory action of this Court for its resolution?

In the instant case the ruling of the Circuit Court of Appeals while recognizing utility and novelty with reference to the art, held the claims to be not patentable. This is a ruling in conflict with the decision of the Circuit Court of Appeals of the Seventh Circuit in *National Slug Rejectors, Inc. v. A. B. T. Manufacturing Corporation,* 164 Fed. (2d) 333, 335 (certiorari denied), where the Court stated:

> "As to utility, it may be said the invention was of small coverage and of even smaller importance.

If the coin selector made possible the rejection of underweighted coins, or served better to eject such coins, it possessed utility. It is not the extent of the utility that governs, but the existence of *some* utility.

Likewise, as to novelty, the improvement or change may evidence no outstanding or revolutionary difference in mechanism. No giant's stride is demanded. Novelty involves the presence of some element or the new position of an old element in a combination, different from anything found in any prior structure". (Emphasis in the original.)

Second: Where in a suit for patent infringement the patent is attacked as invalid and it appears that the claims of the patent defined a new association of old elements giving rise to improved results, can the claims of said patent be adjudicated invalid upon the ground that the elements are old?

Third: Did not the Circuit Court of Appeals err in crediting admissions or omissions with an effect not consonant with the record and affirming the decree of the District Court which dismissed the Bill of Complaint?

Wherefore, your Petitioner prays that this petition be granted and that a Writ of Certiorari issue to the Circuit Court of Appeals of the Seventh Circuit for the purpose of reviewing the questions hereinbefore specified.

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Dated at Chicago, Illinois, August 23, 1948.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The Opinions of the Court Below.

The opinion of the Circuit Court of Appeals for the Seventh Circuit is reported at 168 F. (2d) 334; 76 U.S. P.Q. 497, and appears in the record filed herewith (Rec. p. 2553 to 2567).

The opinion of the District Court is reported at 63 F. Supp. 427; 67 U.S.P.Q. 2, and appears of record filed herewith (Rec. p. 54 to 64).

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered March 6, 1948 (Rec. p. 2567).

Petition for rehearing was denied June 29, 1948 (Rec. p. 2568).

The Statute under which jurisdiction is invoked is *240 (a) of the Judicial Code* (28 U. S. C. Sec. 347) as amended.

STATEMENT OF THE CASE

Facts Necessary to an Understanding of the Questions.

1. Petitioner, Allen-Bradley, and respondent, Square D are commercial rivals in the field of furnishing electric switches for across-the-line starting of electric motors for machine tool application.

2. The art long had recognized the desirability of combining in a three phase motor switch the desirable elements of reliability and compactness but was not able to overcome the age old inclination to extinguish an arc by blowing it into the surrounding air, i.e., by arc dis-

persal. (See unsatisfactory efforts of Condit Co., Rec. pp. 459-466 with quadruple break arc dispersal switches and list of prior patents).

In contra distinction to this arc dispersal custom, Wilms & Petersen impounded and cooled the arc within the hood. Dr. Simon, Allen-Bradley's expert, testified with respect to this Rec. p. 1242 as follows:

> "Q. Do you find in any of the patents or prior uses cited by the defendant against the Wilms and Petersen patent in suit any instance of the arcs being cooled in the way Mr. Van Valkenburg has explained in his direct examination?
>
> A. No, there is not a single instance in the art cited in which the arcs are cooled as they are cooled in the Wilms and Petersen switch as explained by Mr. Van Valkenburg."

3. The art prior to the Wilms and Petersen invention culminated in the Wilms and Dawe switch made by Allen-Bradley according to Wilms and Dawe reissue patent 20,094, Rec. p. 2148. This switch had somewhat of an enclosure for the double break contacts but it was not complete and the switch got rid of the arc at its low rating of 7½ horsepower by blowing into the air, i.e. by arc dispersal. Van Valkenburg, defendant's expert, testified, Rec. p. 813, that it was good for only 7½ horsepower.

This Wilms and Petersen switch was good for 25 horsepower and over.

This Wilms and Dawe work and other prior art is completely disposed of by the following testimony of Dr. Simon, Rec. p. 1242.

> "Q. Why is the closed hood more effective in cooling the arcs in the way Mr. Van Valkenburg has

explained than the open hood in the Wilms and Dawe switch?

A. Because the hot gases are driven against the ends of the enclosing chamber, and thereby the heat of the gas is more effectively absorbed and transferred to the arc chamber. Therefore, the arc gases are retained in the hood and in close proximity to the walls of the chamber, and are thereby more effectively cooled than in the Wilms and Dawe switch with the open hood where hot gases are expelled into the outside air and are not confined so as to be rapidly and effectively cooled."

Further, Dr. Simon in referring to an enlarged Wilms and Dawe switch, Pl. Ex.-85, Rec. p. 575, stated:

"And a switch of the same type (as Wilms and Dawe size 1) but enlarged to have a current carrying capacity so that when it is closed it can carry the same current as a size 2 Wilms and Petersen switch, will break down or short circuit at a current of about 240 amperes, which is not sufficient and not satisfactory as we see it for a No. 2 switch". (Parenthetical statements supplied.)

4. An important part of this field is the furnishing of electric switches for three phase electric motors in sizes in excess of 7½ horse-power.

5. Where motors larger than 7½ horse-power are to be controlled by connecting them directly across the line (that is to say, by impressing the full voltage available upon the motor in one step) the switching equipment employed is subject to deterioration and even destruction due to the electric arcs which results upon actuation of the switch.

6. In 1934 Allen-Bradley brought to the commercial market as an accomplished fact a new three phase across-the-line starter switch for larger horse-power motors of

outstanding reliability and of a compactness not theretofore existing in any commercial switch furnished by anyone, including Square D. This switch was a specific embodiment of the matter disclosed and claimed in Wilms and Petersen patent, in suit, No. 2,071,149.

7. At the time, respondent, Square-D acquired a specimen of this new switch and acquainted itself in detail with its construction. See Van Valkenburg testimony. (Rec. pp. 947-9.)

8. Subsequently respondent, Square D, designed and marketed a new three phase across-the-line switch—a substantial copy of the Allen-Bradley switch, embodying as contended by petitioner, Allen-Bradley, the subject matter of the claims of the patent in suit.

9. The new switch of petitioner Allen-Bradley combined, as in the Wilms and Petersen patent in suit, a bottom to close the hood around each pair of double break contacts and a U magnetic loop through the double break contacts to impound the arcs into the ends of the closed hood and the results were:

1. That the arcs are confined within the hood until extinct and flashover is prevented between the contacts inside the hood or through the actuator opening to opposite poles outside the hood.

2. That the arcs have their ionized gas compacted by the U magnetic loop to raise the interrupting capacity to over double the enlarged Wilms and Dawe switch PX-85.

3. That sufficient interrupting capacity is obtained as is required for across the line control of a 25 horse-power motor.

The interior of the switch in the Wilms and Petersen patent is shown in the drawing PX-75, Rec. p. 1376, as

connected in circuit to start and stop a motor operated on a three phase alternating current supply circuit. This drawing also shows the magnetic loop in the circuit of each phase and consisting of the line 10 the stationary contact 8, the moveable contacts 37, the other stationary contact 8 and the line 18 to the motor.

Plaintiff Exhibit 78, Rec. p. 1377, shows the casing for the set of contacts in each phase and the operation of extinguishing the arc in both the Allen-Bradley patented switch and the Square D accused switch, Plaintiff Exhibit 2. Dr. Simon, Plaintiff's expert explained this action picture Exhibit 78 on Rec. pp. 530 to 535.

10. Throughout the prosecution of the application of the patent in suit and throughout a long litigation encompassing a period of upwards of nearly fourteen years, there were divergent or changing views on the part of the patentees, their experts, the experts of respondent and the independent expert of the Court as to the specific phenomenon involved in producing a reliable switch of compact dimension. On appeal however the parties appear to have agreed upon and the Court adopted the view that the impounding of the arcs in the ends of the hood by means of the U-shaped magnetic field was the gist of the desirable result. Throughout all this the fact has remained and is recognized in the decision of the Circuit Court of Appeals, that a distinct step from the standpoint of improvement was made in the switch art upon the introduction of switches made in accordance with the disclosure of the patent in suit. Successful switches continued to be made in forms constituting almost exact embodiments of the drawings of the patent in suit, and the switches of respondent differ therefrom only in non-essential detail.

11. The Circuit Court of Appeals, however, has ignored the legal effect of the advance and improvement in the art resulting from the patent in suit and the legal effect of the novelty of the combination called for by the claims by holding that the prior Wilms and Dawe switch good only for controlling a 7½ horse-power motor, not having a closed hood and operating on the old arc dispersal principle prevented patentable novelty being accorded to Wilms and Petersen.

SPECIFICATION OF ERRORS

The errors which Petitioner will urge, if the Writ of Certiorari is granted, are set forth by the questions presented in the petition for Writ of Certiorari (Supra, pages 4 to 5).

SUMMARY OF ARGUMENT

1. The Circuit Court of Appeals after attributing to Wilms and Petersen a new and useful improvement in three phase control switches of the type shown in the Wilms and Dawe patent, denies invention to the patentees in contravention of the law of the Seventh Circuit as enunciated—with a different bench—in the case of *National Slug Rejectors, Inc. v. A. B. T. Manufacturing Corporation,* 164 Fed. (2d) 333, 335, Petition for Writ of Certiorari denied February 9, 1948, rehearing on Petition denied March 8, 1948. The opinion in that case by His Honor Judge Evans states: (P. 335)

> "As to utility, it may be said the invention was of small coverage and of even smaller importance. If the coin selector made possible the rejection of underweighted coins, or served better to eject such coins, it possessed utility. It is not the extent of the utility that governs, but the existence of *some* utility.
>
> Likewise, as to novelty, the improvement or change may evidence no outstanding or revolutionary

> difference in mechanism. No giant's stride is demanded. Novelty involves the presence of some element or the new position of an old element in a combination, different from anything found in any prior structure." (Emphasis original).

The Wilms and Petersen switch qualifies as patentable under this statement of the law.

See also *Iron Fireman Mfg. Co. vs. Industrial Corp.*, 89 F. (2d) 904, 909 (C.C.A. 7).

The desirability of this Court exercising its discretion to dispel the confusion which has arisen within the Seventh Circuit out of decisions such as has been rendered in the instant case at variance with the decision in the Slug case is extremely patent. A like desirability for the Second Circuit is strongly pointed out in the dissenting opinion of Judge Frank in *Triangle v. Rohrlich, et al.* (*Miss Seventeen Foundations Co.*) 167 Fed. (2d) 969, 981, (C.C.A. 2) wherein the following statement occurs:

> "I think that anyone reading the decision in the Best case and the decision here will be in considerable confusion about the doctrine of confusion in this circuit. On that ground, also it seems to me the Supreme Court should review this decision." (p. 981)

Judge Frank was referring to the just previously decided trademark infringement case in the Second Circuit of *Best v. Miller,* 167 F. (2d) 374, in which case a petition for a writ of certiorari has been made to this Court.

Without an authoritative determination by this Court, the success of a plaintiff, seeking to protect his patent in the Seventh Circuit, will continue to depend more on the accident of the Court's composition than on any certainty of settled rule in the Circuit.

The decision of the Court of Appeals in denying invention because of want of utility runs counter to the decisions in the Fourth Circuit; for example,

Lever Bros. Co. vs. Proctor & Gamble Mfg. Co., 139 F. (2d) 633, 638 (C. C. A. 4), where the Court, quoting from the decision of this Court in *Diamond Rubber Co. vs. Consolidated Tire Co.,* 220 U. S. 428, 435, in speaking of an inventor, said:

> "* * * If he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor."

and then, after discussion as to the fact that he need not know the scientific principles underlying his invention but must make a clear description, continues:

> "This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it."

There is another reason why the case should be reviewed and that is that defendant, by slavishly copying plaintiff's structure, is estopped from denying utility. *Nestle-Le Mur Co. v. Eugene,* 55 Fed. (2d) 854, 856 (C. C. A. 6) (1932), p. 856:

> "We have no doubt that by copying and using the patented device the defendant has estopped itself from claiming want of utility in the sense of the patent statute."

United States Gypsum Co. v. Consolidated Expanded Metal Companies, 130 Fed. (2d) 888, 889 (C. C. A. 6) (1942), p. 889:

> "Though it be elementary to do so at this late date in the development of the patent law, it is necessary to recall that three elements are requisite to validity, to-wit: Novelty, utility, and invention. It has been held in adjudications without number,

that one who appropriates the teachings of a patent may not deny the utility of the invention."

2. The Circuit Court of Appeals erred in denying patentable invention to Wilms and Petersen by erroneously stating that the sole novelty was the closing of the hood at the bottom (opinion Rec. p. 2562) after correctly pointing out (Rec. pp. 2558-2559) that the new combination consists of combining (1) a bottom to extend under the bridge bar and close the hood at the bottom and (2) a "U" magnetic loop through the contacts to impound and compact the ionized-arc gas in the closed ends of the closed hood. This is a new and useful combination meeting with surprising commercial success, Rec. p. 357, and should be held patentable under the law.

Further, with respect to the principle, the record amply establishes that impounding and compacting the arcs in a three phase switch by means of the cooperation between the "U" magnetic loop and the closed bottom of the hood was new and in contradistinction from the operation of the prior three phase Condit switch which, because it operated on the old arc dispersal principle, had to have quadruple breaks in order to even remotely approach the range of the Wilms and Petersen switches.

The Circuit Court of Appeals denied to Wilms and Petersen patentable invention on the assumption that they had made only a larger capacity switch whereas even if that had been all that Wilms and Petersen did they should not have been denied patentable invention under *Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, where this Court sustained a patent on an automatic heel lasting machine—an improvement on the lasting machine described in an earlier patent by the same inventor and also owned by the owner of the

patent in suit. The prior patented machine would work satisfactorily upon shoes of a small range of sizes but not on a wide range of sizes. This Court said respecting the patent there in suit, p. 366:

> " * * * The improvements embodied in the claims in suit had to do with a new combination of elements for clamping the last in the machine, a new combination of elements for the operation of wipers and tackers in fixed relation to each other and to the heel of the last, and a new combination of means for positioning the last vertically and automatically altering the position during the operation. A manual adjustment was a part of each of these combinations by which the heel clamping, the wiping and tacking, and the vertical positioning mechanisms could be adjusted in advance for different sizes of shoes."

The problem was solved as Wilms and Petersen solved the problem left by their immediate predecessors Wilms and Dawe, by creating a new combination to increase the range of use of the prior device.

Likewise under the doctrine of *Eibel Co. v. Paper Co.,* 261 U.S. 45, sustaining a patent for bringing about a speeding up of the operation of a paper making machine Wilms and Petersen should not have been denied patentable invention.

See also *Seymour vs. Osborne,* 11 Wall (U.S.) 516; *Loom Co. vs. Higgins,* 105 U.S. 580; *Goodyear vs. Ray-O-Vac,* 321 U.S. 275; *Luten vs. Kansas City,* 285 F. 840.

3. The Circuit Court of Appeals erred in according undue importance to the writings and cross-examination of Wilms, one of the inventors, as to the merits of the invention contrary to the law as outlined in *Glade v. Walgreen Co.,* 122 Fed. (2d) 306, (C. C. A. 7th) 1941.

Wilms at the time was a man of some age and looking backward was simply over modest. His testimony given under cross-examination is at variance with the actual facts as to the difficulties experienced by him and Petersen in developing the switch of the patent in suit. This is detailed in the record on pp. 191-200. These experiments were of various kinds, covering a wide field and a large amount of time, e.g., starting with the Wilms and Dawe switch, they tried making the hoods larger (Rec. p. 191); they made the barriers twice as high (Rec. pp. 191-2); they tried different ranges of contacts over "quite a long period of time" (Rec. p. 192); they tried deion plates (Rec. p. 193); they tried a switch wherein the contacts had a resistance parallel to the switch gap (Rec. p. 193); they tried inserting an arc strainer in the bottom (Rec. p. 193); they tried inserting the arc strainer and having barriers on the top (Rec. pp. 193-4); they tried inserting iron between the movable contacts (Rec. p. 195); they tried reducing the size of the gap (Rec. p. 196); they tried making the contacts of coin silver, of zinc silver, and an arc barrier with copper contacts (Rec. p. 197); they tried brass barriers instead of asbestos barriers (Rec. p. 197); they tried various alloys of silver, copper, etc. (Rec. pp. 198-9); and finally cadmium silver contacts in combination with the structure of the arc hood, the movable contact bar and an actuator going through the bottom of this enclosed chamber (Rec. p. 201).

In fine, notwithstanding the inadvertent admission of Wilms, he and his associates conducted long research over a period of almost two years in an attempt to obtain the desired interrupting capacity and ultimately obtained the unexpected result by reason of a combination which compacted the impounded arcs in the ends of the enclosed hood.

The Circuit Court of Appeals should have disregarded the admission in the light of the record herein.

In *Glade v. Walgreen Co.*, 122 F. (2d) 306, 309, the Circuit Court of Appeals itself said:

> "* * * However, it would make no difference if both parties admitted it (the truth of plaintiff's assumption as to invalidity), if in fact, it was not true, for the statute does not contemplate that the court shall be bound by admissions in determining the question of patentability."

To the same effect, see *Art Metal Works Inc. v. Abraham & Straus, Inc.*, 107 F. (2d) 940, 943 (1939) where the Circuit Court of Appeals said:

> "* * * The positions taken by experts and counsel upon the trial cannot control the law of the case."

CONCLUSION

For the reasons stated the writ should be allowed.

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Aug. 23, 1948.

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REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Oct. 13, 1948.

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No. 246

REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Apparently respondent concedes that in case of conflict of opinion between different benches of a Court of Appeals it is the province of this Court to decide the issue to the end that the law of the circuit may be definite and uniform for in its brief it avoids the issue.

It contents itself with a discussion to the effect that there is no inconsistency and confusion in the Court of Appeals for the Seventh Circuit. On this issue it fails utterly as will shortly be shown.

Respondent claims that there is no issue of public importance raised and no novel principle of patent law involved. Firstly, there is the issue of what the law as to invention is in the Seventh Circuit and likewise in the United States in view of the decisions in other circuits and in view of the fact that a petition for a writ of certiorari in the case of *National Slug Rejectors, Inc.* vs

A.B.T. Mfg. Corp. 164F2D333, was twice denied by this Court, 333 U.S. 832, 68 S.C. 459, 333 U.S. 850, 68 S.C. 658, and Secondly, there is the novel issue of patent law involved; viz., is novelty and utility of prime importance in determining presence of invention?

Respondent does not contest the proposition that the three phase switch of the Wilms and Petersen patent in suit has utility, as it could not in view of the record, which shows that the principle and construction of that switch more than doubled the size or capacity of the motor which it could control (P. Ex. 83, R. pp. 581, 1385), but contents itself with attacking the novelty of the switch. On this point Respondent confuses actual novelty with inventive novelty which latter the Court of Appeals had in mind in deciding the instant case. As to actual novelty, Respondent in deprecating the improvement made in the Wilms and Petersen switch has reiterated that the only change made over the Wilms and Dawe switch was the placing of a bottom wall in the hood and the District Court in finding 29 (R. p. 105), quoted by the Court of Appeals held that: "Adding the bottom wall to the Wilms and Dawe switch, to enclose completely the contacts except for a single opening in the bottom wall through which the actuator passes, is a mere mechanical device", etc. The Court of Appeals even stated that, "the question arises as to whether the means employed to obtain the *improved result* — the enclosure of the hood at the bottom—was of such an ingenious nature as to amount to invention." (R. p. 2562) (emphasis added). Surely it is clear from the above that there was actual novelty in the Wilms and Petersen switch. And the Court of Appeals clearly differentiates this from inventive novelty which it would not accord to Wilms and Petersen contrary to the law as laid down by a different bench in the *slug* case.

Of course there are other differentiations between the Wilms and Petersen switch and the Wilms and Dawe switch such as the encasement of the contact springs which were specifically mentioned by the District Court (R. p. 101) and the Court of Appeals (R. pp. 2564-5) and, aside from their presence showing actual novelty, this accentuates the difference in principle of operation between Wilms and Petersen and Wilms and Dawe, since the encasements became necessary to protect the springs against the arcs when the arcs are impounded in Wilms and Petersen as differentiated from being dispersed into the surrounding air in Wilms and Dawe according to the age old dispersed arc principle.

Coming now to the question of conflict between the decisions of one bench in the *slug* case and of another bench in the instant case, we have shown that in the instant case the Court of Appeals held that even though there was actual novelty and utility in Wilms and Petersen it would not accord invention to these inventors even though their switch had met with surprising commercial success (R. p. 357). We have also shown the importance attributed to actual novelty and utility in the *slug* case. Respondent however states:

> "The patent in the *National* [*slug*] case was sustained, not only because the device was *new* and useful but because in view of the prior art and the other facts in the case, the Court was persuaded that the prerequisite of patentability, i.e. inventiveness, was also present." (emphasis copied) (Res. brief p. 8).

This statement is directly in contradiction of the statements of the *slug* opinion. The opinion in the *slug* case quotes the law with emphasis as showing that *"any new and useful art"* may be the subject of a patent and immediately states thereafter that: "The statute exacts no-

thing more." The opinion then states that the Courts "have long if not always, required that there be something about the novelty which makes the 'new' in the mechanism something to cause the Court to say 'here an inventor labored' ". This latter is not "a first prerequisite". Novelty and utility are the first prerequisites of invention.

But even assuming that novelty and utility were not of prime importance in the *slug* case opinion, the opinion is still at variance with the holding in the instant case, for there is not closer prior art in the instant case than Wilms and Dawe. It is also shown that physically something had to be added to that and the record shows that the Wilms and Petersen switch met with surprising commercial success (R. p. 357). Thus we have a parallel to the *slug* case as to actual novelty and utility and yet different benches decided the same question differently.

Respondent on page 2 of its brief states in effect that the courts below found that the Wilms and Petersen patent did not disclose a new combination having a novel principle and producing a new result but fails to state where this is set forth. There is no such statement by either Court and there could not be any such valid statement for there was a new combination with the bottom of the hood to cause an impounding of the arc which was a principle not found in any prior art switch structure as all of the prior comparable switch structures operated on the old arc dispersal principle and a new result was the producing of a switch which would control a larger motor (P. Ex. 83, R. pp. 581, 1385).

Respondent undertakes to restate on pages 2, 3 and 4 of its brief the construction of the Wilms and Petersen switch but all that it does is to recite non-essential details of construction of the figures of the patent and omits

fundamental characteristics such as that the switch is of the three phase type and that it provides pockets or ends for impounding of the arcs. Even the District Court regarded the switch as a three pole affair (R. p. 54) and the Court of Appeals recognized it as a three phase structure wherein flashover between phases is a feature to be guarded against (R. pp. 2554-5). Respondent even likens the patent structure to the Wilms and Dawe structure because in both the arcs are driven against the side walls of the hood for cooling but neglects to point out that the arcs are compressed into the ends of the hood and are not dispersed into the air as in the Wilms and Dawe structure.

Respondent attempts to make much of the findings of fact by the District Court but these viewed in the light of the decision of the Court of Appeals are properly relegated to the class of unimportant and inconsequential details. The only finding material to the issue decided by the Court of Appeals is No. 29 (R. p. 105), which is really a conclusion of law, and which sets forth the fact that a part — the bottom plate — was added to Wilms and Dawe making a new combination and producing a new result. The only real and material concurrence between the District Court and the Court of Appeals is in holding that the new and useful features of Wilms and Petersen did not entitle them to the status of inventors — contrary to the rule in the *slug* case.

As shown in our prior brief, theory of operation is not important and lack of theory or a wrong theory does not militate against the validity of a patent of a workable structure.

As the parties and the Court of Appeals are in practical agreement upon the impounding of the arc by reason of

the fact that the lower wall of the hood encloses the contacts and bar and this is recited in the claims, there is no basis for the charge of indefiniteness of the claims in suit.

Likewise there is no basis for the charge that new matter was introduced by the amendment to the Wilms and Petersen application of October 10, 1936, when claims 21 to 24 and 26 in suit were made, for claims 2 and 20 were made prior to that time and before respondent purchased the Allen-Bradley switch PX-44 to design its switch PX-2 (R. p. 1268) and were allowed April 25, 1936, before Respondent's switch PX-2 was placed on the market. Claim 20, made February 1936, is broader than claims 21 to 24 and 26 in suit and combines double break contacts arranged in a closed chamber at each pole, a carrier having a spring contact holder passing into each chamber through an opening, and a spring shield movable with the contact holder and substantially closing the opening into the hood. Claim 2 *in the original application* is even broader than claim 20, as it specifies merely contacts, instead of double break contacts, in the same combination as in claim 20.

Moreover, Respondent cannot claim immunity from infringement of the patent by reason of the prosecution of the application, as it did not have any knowledge of the invention described and claimed, save the Allen-Bradley switch PX-44, from which it made its copied infringement of the patent issued on the application.

CONCLUSION

For the reasons stated the writ should be allowed.

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Oct. 13, 1948.

FILE COPY

Supreme Court of the United States

October Term, 1958

No. 246

ALLEN-BRADLEY COMPANY,

Petitioner,

vs.

SQUARE D COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1948.

No. 246.

ALLEN-BRADLEY COMPANY,

Petitioner,

vs.

SQUARE D COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

MAY IT PLEASE THE COURT:

This is an ordinary patent infringement case in which the courts below have concurrently *invalidated* petitioner's patent (Wilms and Peterson, No. 2,071,149).

There is no conflict between Circuit Courts of Appeals regarding the validity, scope or infringement of the patent. No basic issue of public importance is raised by the petition and no novel principle of patent law is involved. While it is claimed that there is inconsistency and confusion in the decisions of the Court of Appeals for the Seventh Circuit—a contention which we shall show to be entirely unfounded—a reading of the opinion of that court in the instant case[1] reveals that the conclusion of invalidity is

1. 168 F. 2d 334; R. 2553-2567.

in harmony, and not in conflict, with applicable decisions of this Court. It is manifest that in these circumstances, the petition ought to be denied. Cf. *Keller et al.* v. *Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corp.* v. *Western Well Works*, 261 U. S. 387, 393.

The petition and supporting brief proceed on the premise —contrary to the facts found by the courts below—that petitioner's patent discloses a new combination having a novel principle and producing a new result; also, they omit essential facts necessary to an understanding of the matter involved. Accordingly, the basic facts will be restated and we shall then show that the reasons relied upon for allowance of the writ are wholly devoid of merit.

Restatement of the Matter Involved.

1. Petitioner's patent (R. 2481) discloses an electric switch of the vertical or straight line type having a hood formed of insulating material completely enclosing the contacts of the switch except for a single opening in the bottom wall through which passes the actuator for the movable contact. The hood is composed of *three readily separable sections* to facilitate access to the contacts for inspection and repair. (Finding of Fact No. 5, R. 101.)

2. The patented switch is of the double break contact type and includes spaced-apart stationary contacts adapted to be bridged by the movable contact when the switch is closed, the contacts being formed of a silver cadmium alloy which has a deionizing effect on the arcs. (*Ibid.*)

3. The actuator for the movable contact is disposed below and outside of the hood, and the contact holder which passes through the single opening substantially closes the opening, it being only sufficiently large to permit the contact holder to slide easily through it. (*Ibid.*)

4. The switch contacts and the conductors leading thereto are so arranged as to form a magnetic loop to spread the arcs apart from each other. (*Ibid.*)

5. Respondent's first switch was placed on the market in July, 1936. It is not true, as stated by petitioner (pp. 9, 13), that this construction was a slavish copy of or like the sectionalized hood of the patent in suit. As was found by the trial court, respondent's device was not covered by the application for patent as it then stood (Finding of Fact No. 13, R. 103). None of the accused devices uses silver cadmium contacts (Finding of Fact No. 35, R. 106); none operates to effect rapid venting of deleterious gases through the clearance about the contact actuator after extinguishment of the arc (Finding of Fact No. 36, R. 106) as is taught in the patent in suit; and all, save the small size switches, have magnetic yokes within the hoods to assist in spreading the arcs and cooling the arc gases (Finding of Fact No. 38, R. 106-7), a device not taught or suggested in the patent in suit.

6. Until the advent of respondent's first switch in July, 1936, the patentees were asserting in the Patent Office that their patentable improvement resided in their particular sectionalized hood which permitted ready accessibility of the contacts for inspection and repair (R. 1685). Thereafter in October, 1936, the application of the patent in suit was amended to introduce new matter which found no support in the original application and which served as the basis for new claims, such as No. 21 in suit. These new claims were not restricted to a sectionalized hood, but called broadly for an enclosing hood for the contacts and a single opening leading thereinto, *i.e.*, a clearance about the contact actuator, through which, according to the new matter, rapid venting of the gases after extinction of the arcs was effective. This was asserted to be a new

principle of operation and it was on this theory that patentability was predicated.[2]

7. Upon the trial, the principle of operation upon which allowance of the claims had been secured was abandoned and petitioner's expert advanced a directly contrary theory which the District Court found, however, not to be established by the testimony (R. 59, 60).[3] On final argument in the District Court, still another theory, also contradicting the statements made to the Patent Office, was presented, but this theory was likewise found not to be supported by credible evidence (R. 60).[4] In the Court of Appeals it was claimed that the patentable improvement is for a new combination of a closed hood around each pair of contacts and a U magnetic loop to impound the arcs into the ends of the closed hood, thereby resulting in increased interrupting capacity, confinement of the arcs until extinction and prevention of flashover.

8. Wilms, one of the patentees, testified, however, that the "problem of arc interruption was solved" when the silver cadmium contacts were first employed (R. 205). This improvement is not embraced in the patent in suit; it is, rather, the subject of another patent owned by petitioner, *i.e.*, No. 1,940,961 (R. 2402).

9. The patentees also admitted during the prosecution of the application for the patent in suit that complete enclosure of the contacts was known in the art and was dictated by past experience (R. 1683-5).[5] Quite apart from this admission which had been necessitated by the citation of the prior patents to Thomson (R. 2203) and Ancotti *et al.* (R. 2195), the District Court found that

2. See Findings of Fact Nos. 14, 15, 16 & 17, R. 103-4.
3. See Findings of Fact Nos. 19, 20, 21, R. 103.
4. See Finding of Fact No. 22, R. 104-5.
5. See also Finding of Fact No. 9, R. 102.

complete enclosure of contacts was old and well known as evidenced by at least eight other patents (Finding of Fact No. 10, R. 102).

10. Moreover, the use made in the switch of the patent in suit of a U-shaped loop in conjunction with a double contact arrangement which tends to cause the two arc columns to spread from each other is the same as that disclosed in the prior art Wilms & Dawe patent No. 1,981,534 (R. 2148). It is this action which drives the arc gases against the side walls of the hood and sets up a turbulence in the chamber which increases the rate of deionization of the hot gases and tends to interrupt the arc at the point of current zero (Finding of Fact No. 24, R. 105). Cooling is also obtained by impounding the arcs, this effect being dependent upon the spacing of the walls from the contacts, the area of the walls and the material from which the hood is made (Finding of Fact No. 25, R. 105). The cooling effect of a hood was appreciated and taught not only by the prior Wilms and Dawe patent No. 1,981,534, but also by the prior patents to Wilms and Loock No. 1,804,729 and Wilms No. 1,901,573 (Finding of Fact No. 26, R. 105).

11. The District Court found that the enclosed hood of the patent in suit does not involve invention over the prior art Wilms and Dawe patent. In its painstaking opinion the District Court found that adding a bottom wall to the Wilms and Dawe switch, to completely enclose the contacts except for a single opening in the bottom wall through which the actuator passes, "is a mere mechanical device permitting the moving of the movable contacts" into and out of engagement with the fixed contacts (R. 62-3). The District Court also found the patent in suit invalid because (a) its description is "too indefinite" and not a

compliance with the provisions of 35 U. S. C. § 33[6], and (b) new matter had been improperly added, after the advent of respondent's device (R. 63-4).

12. Affirming the District Court, the court below found (R. 2564) that there was "nothing novel, either in the principle or the result" of the device disclosed in petitioner's patent and it expressly agreed with the District Court that the "means employed" by the patentees did not rise above mere mechanical skill (R. 2562). In view of its concurrence in the District Court's conclusion that patentable invention had not been shown, the court below considered it unnecessary to pass upon the other grounds utilized by the trial court for the judgment invalidating the patent (R. 2565).

6. As pointed out by the District Court, the chameleon-like character of the description is such that plaintiff "could claim at one time a complete enclosure, at another an opening permitting rapid venting of the gases and at another a throttling which would prevent rapid but permit slow escape of the gases." (R. 63.)

ARGUMENT.

I.

There Is No Confusion in the Seventh Circuit Regarding the Standard of Invention.

The chief trouble with petitioner's first point is that petitioner erroneously assumes that in *National Slug Rejectors, Inc.* v. *A. B. T. Mfg. Corp.*, 164 F. 2d 333, a *modicum of utility* and a *modicum of novelty* were regarded by the Seventh Circuit Court of Appeals as a sufficient standard of invention complying with the requirements of the patent statutes (35 U. S. C. § 31).

Of course, the court below did not fix any such standard in the *National* case; to have done so would have constituted a departure from *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, where this Court held that *utility* and *novelty* do not necessarily make a device patentable and that under the statute a device "must not only be 'new and useful,' it must also be an 'invention' or 'discovery'."

Thus it will be found upon reading the opinion in the *National* case, that following the limited language quoted by petitioner, the court expressly stated (164 F. 2d 335) that a certain "kind or quality of the novelty" must be present and that the courts have long, if not always, required—

> "* * * that there be something in the originality,—something about the novelty, which makes the 'new' in the mechanism something to cause the court to say 'here an inventor labored.'
>
> "This century-old question is always perplexing. We can not avoid or evade it. We must meet it."

The patent in the *National* case was sustained, not only because the device was *new* and *useful*, but because in view of the prior art and the other facts in the case, the court was persuaded that the first prerequisite of patentability, *i. e.*, inventiveness, was also present.

Nor is there any inconsistency between the standard of invention adopted in the case at bar and that applied in *Iron Fireman Mfg. Co.* v. *Industrial Engineering Corp.*, 89 F. 2d 904. Validity was not upheld in that case simply because of novelty and utility; it appears, rather, that the court expressly considered inventiveness and rejected (p. 909) the contention that the improvement was nothing more than that which any electrician would adopt in the exercise of mechanical skill.

Finally, it should be noted that petitioner's assertion (p. 13) of a conflict with the Fourth Circuit decision in *Lever Bros. Co.* v. *Procter & Gamble Mfg. Co.*, 139 F. 2d 633, is both unwarranted and unsound. In the first place, the court below, contrary to petitioner's assumption, did not deny invention "because of want of utility," and, secondly, it is a meaningless quibble to complain about respondent's alleged estoppel to deny utility when the decisions below rest on the fact finding that the exercise of the inventive faculty is shown by the evidence to be wanting.

II.

The Court of Appeals Has Not Departed From the Principles of Patent Law Announced in Decisions of This Court.

The settlement of the question raised by petitioner's second point is of importance only to petitioner for it does no more than advance petitioner's case on alleged patentable invention which both of the courts below refused to

adopt. Indeed, petitioner is really seeking a retrial in this Court of this issue, and would have this Court overturn concurrent findings and redetermine the fact question of whether the improvement required mere mechanical skill or the exercise of the faculty of invention. This Court, under a settled rule, has repeatedly held that it will not disturb concurrent findings on questions of fact unless they are clearly erroneous. *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 278; *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367; *Thompson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446, 447; *Adamson* v. *Gilliland*, 242 U. S. 350, 353; *Battin* v. *Taggert*, 17 How. 74, 85.

Petitioner does not succeed in showing the findings of the court below to be "clearly erroneous" simply by assuming that the principle of the switch of the patent in suit is new and by misstating the grounds of the Court of Appeals' conclusion of invalidity. The appraisal by the court below of the "new" combination as consisting of two elements was one of limitation gleaned from petitioner's brief (R. 2558-9). After noting that petitioner did not attack the trial court's finding that each element was old and well known,[7] the court below made its own examination of the prior patents and pointed out (R. 2561) that it was not "open to dispute" that the "magnetic loop feature as well as the enclosed hood were old." The court below said that even when it was assumed that the arcs are more securely impounded and more rapidly extinguished in an enclosed hood, *i. e.*, that a better result is obtained, it was nevertheless compelled to agree with the trial court that the "means employed" was not of "such an ingenious nature as to amount to invention." The court went on,

7. Thus the Court said (R. 2559): "The court below, as already noted, found that both of the elements relied upon were old and well known and, so far as we are aware, plaintiff makes no attack upon such finding."

moreover, to review the proceedings in the Patent Office and the admissions of the patentees that past experience had dictated complete enclosure and concluded (R. 2564) that under a "most generous appraisal" of the claimed invention there was "nothing novel, either in the principle or the result."

The decisive answer to petitioner's contention that such cases as *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, and *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, require a reversal of the judgment is that the court below regarded the question of patentable invention *sub judice* to be controlled by, and rested its conclusions primarily upon, such decisions of this Court as *Smith* v. *Nichols*, 88 U. S. 112, 119 (a mere change in degree), *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 60 (merely providing a necessary hole in a bottom wall), *Planing-Machine Co.* v. *Keith*, 101 U. S. 479 (merely enlarging proportions and sizes of parts), and *Electric Cable Joint Co.* v. *Brooklyn Edison Co. Inc.*, 292 U. S. 69, 79, 80, and *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 486 (mere substitution or other advance plainly indicated by the prior art).

III.

No Basic Conclusions Unsupported by Other Evidence Were Drawn from the Patentee's Writings and Admissions.

Petitioner's third point is without merit because the court below did not invalidate the patent solely because of statements in an article written by the patentee Wilms and his admissions elicited on cross-examination.

Reference was made to the article to show (R. 2562) that the patentee had not recognized in October, 1935, the "novel

features which are now claimed as invention," and his cross-examination was quoted to establish his own appraisal—*superficial* "minor differences"—of the "principles" found in the switch of the patent in suit and that of the prior Wilms and Dawe patent. But no basic conclusions were *per se* rested upon the writings and admissions. This is manifest both from the Court's earlier agreement with the trial court that the exercise of invention had not been shown and from its own earlier independent conclusion, *viz.* (R. 2562):

> "We should think that it would hardly require the skill of a mechanic to appreciate that an element so elusive as an electric arc could be more readily and firmly impounded in a hood enclosed on all sides than in one open at the bottom."

Since a case "made out in all its elements by cross-examination of opposing witnesses is a strong case" (*Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, 53), it was of course eminently proper for the Court to indicate in its opinion the confirmation and support, found in the patentee's writings and testimony, of its conclusions which had been reached on other evidence.

Conclusion.

There are not present in this case any of the grounds which the prior decisions of this Court have held were essential to move it to grant a writ of certiorari in a patent infringement case. Moreover, petitioner does not attack either of the additional grounds utilized by the trial court to invalidate the claims in suit. These grounds, *i. e.*, indefiniteness and new matter, or either thereof, adequately support the judgment below. It would seem to be entirely futile in the premises, therefore, to grant a review, for not only has petitioner failed to show clear error in the con-

current findings of no invention, but the result reached below is in any event correct and justified in view of other sound, unassailed reasons.

Accordingly, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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